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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/473,702	12/29/1999	EVAN HOWARD LOTT		1341

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SALT LAKE CITY, UT 84102

EXAMINER

CHANCE, JANET D

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 03/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/473,702

Applicant(s)

LOTT, EVAN HOWARD

Examiner

Janet D. Chance

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 12-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Notice to Applicant*

1. This communication is in response to the request for continued examination filed 12 February 2003. Claims 12-22 are pending.

### *Claim Rejections - 35 USC § 103*

2. Claims 12-13, and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garrett et al. (5,325,291), and further in view of May (May, Jerrold, "A Hybrid system improves claims auditing at Blue Cross").

(A) Claim 12 has been amended to now recite a database of "available accurate, inaccurate, repetitive, complete, and incomplete information concerning" a. in-force insurance policies, b. driver information and c. vehicle information. As per this limitation, Garrett teaches the insurance policy information, the driver information and the vehicle information (Garrett; col. 1, lines 40-60), the inaccuracy due to untimely updates, and the subsequent accuracy after update (Garrett; col. 1, lines 55-65), ascertaining the accuracy by verification of the pre-selected data fields in each database (i.e. complete and accurate) (Garrett; col. 2, lines 5-15, col. 4, lines 15-20), finding mismatched data including data missing from either database (i.e., inaccurate or incomplete) (Garrett; col. 3, line 66 to col. 4, line 30, col. 5, lines 4-12), checking for duplicate drivers records (Garrett; col. 4, lines 30-40) in the exceptions database, and the system allows for further accuracy checks between the databases (Garrett; col. 5, lines 15-20). However, it is

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unclear in Garrett if the duplicate checks are performed on the input information. It is common practice when checking for inaccuracies to check for any and all types of inaccuracies in data including duplicates. In fact one of ordinary skill in the art would know that duplicate records is one of the most common problem in any database system. New records get entered without the operator checking that a record already exists. Therefore it would have been obvious to one of ordinary skill in the art to add the check for duplicate (i.e., repetitive) records in the source databases to the system of Garrett that checks for accurate, inaccurate, complete and incomplete data with the motivation of enabling "the user to identify the presence of data information errors made in the creation of vehicle and/or insurance records" (Garrett; col. 2, lines 19-21).

Further, May teaches the checking for inaccurate and incomplete data records (May, page, 68, col. 2, paragraph 2, page 71, col. 1, lines 1-3 and page 72, col. 1, lines 1-4). It would have been obvious to one of ordinary skill in the art at the time of the invention to add the features of May to the system of Garrett with the motivation suggested by May of reducing the delays in processing that were adversely affecting customer service (May; page 75, col. 2, lines 16-22).

(B) Claims 13, and 15-16 have not been amended and, are therefore, rejected for the same reasons provided in the previous Office Action (paper number 8).

3. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Garrett and May as applied to claim 12 above, and further in view of the New York State Department of Motor

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Vehicles (Anonymous, "Motor Vehicle Liability Insurance Reporting Implementation Guide", Version 1.0, 1 April 1999).

(A) Claim 14 has not been amended and therefore is rejected for the same reasons as provided in the prior Office Action (paper number 8), and incorporated herein.

4. Claims 17-18 and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garrett and May as applied to claim 12 above, and further in view of Johnston (Johnston, Michelle Dally, "State Targets Scofflaw Drivers Database to Reveal Who Is Insured").

(A) Claims 20 and 21 have been amended in the same fashion as claim 12 and, are therefore, rejected for the same reasons provided for claim 12 above, and incorporated herein.

The remaining limitations of claims 20-21 are rejected for the same reasons provided in the prior Office Action (paper number 8), and incorporated herein.

(B) Claims 17-18 have not been amended and, are therefore, rejected for the same reasons provided in the prior Office Action (paper number 8).

5. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Garrett and May as applied to claim 12 above, and further in view of Bosco et al. (5,191,522).

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(A) Claim 19 has not been amended and, is therefore, rejected for the same reasons provided in the prior Office Action (paper number 8).

6. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Garrett, May, and Johnston as applied to claim 21 above, and further in view of Deppa et al. (5,732,198).

(A) Claim 22 remains unchanged from amendment filed 6 September 2002 and therefore is rejected for the same reason provided in the prior Office Action (paper number 8), and incorporated herein

*Response to Arguments*

7. Applicant's arguments filed 12 February 2003 have been fully considered but they are not persuasive. Arguments will be addressed in the order they appear.

(A) Applicant argues on pages 4-5 that "Applicant's employment of all available data, whether accurate or not" [...] "is not disclosed in the references cited by the Examiner" or in the knowledge of one of ordinary skill in the art. Examiner disagrees. Garrett does teach inaccuracy and incomplete data and May teaches inaccurate and incomplete data as cited in section 2(A) of this Office Action and as cited in prior Office Actions. Therefore a prima facie case of obviousness has been established.

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Further Applicant argues that neither Garret nor May suggest process all available info, including inaccurate information. Examiner respectfully disagrees. Both Garrett and May both expressly teach the processing of inaccurate data and accurate data and the corrections where required. Expressly teaching is the ultimate form of obviousness, therefore a prima facie case is established.

(B) Arguments on pages 5 through 7 rehash the arguments from the 16 September 2002 Amendment (paper number 7) which were addressed in the Final Action (paper number 8).

(C) Applicant argues on page 8 that Examiner has improperly used hindsight to reject claim 22 as the "Examiner has failed to identify exactly what prior art she is relying on as "ordinary skill". Claim 22 describes a printer. The Deppa reference, as cited in both prior Office Actions, teaches printer technology. Since printer technology is so old and well known in the art it most certainly would be obvious to one of ordinary skill in the art at the time of the invention to combine the references for the motivation cited.

Applicant is guessing as to the basis for the rejections of paragraphs 4 and 6 on pages 9-10 of the Final Rejection (paper number 8). Explanation has already been provided for these responses to arguments, however, Examiner will attempt to simplify paragraphs 4 and 6 to make these responses do not leave the Applicant guessing. Paragraph 4 discusses the Applicant's argument that "Garrett and May do not disclose the percentage quantities of 96...99 and 95.8" Examiner rejected the claim based on a U.S.C. 103 obviousness type rejection that one of ordinary skill in the art would have found it obvious to perform the accuracy processing of

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Garrett and May to the recited percentages with the motivation as cited in the prior Office Action. Examiner further states that since an obvious type rejection was made, the issue at hand is not that the cited art does not state these limitations, but whether it would have been obvious to one of ordinary skill. Examiner maintains the obviousness of these limitations.

Paragraph 6 discusses the Applicant's argument that improper hindsight was used. Examiner cited *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA) which states that reconstruction based on support and motivation in the references themselves or from logical reasoning, is proper. Since the rejection provided was based on support and motivation in the references themselves or from logical reasoning, it therefore, is proper.

Applicant argues that Examiner arbitrarily ignored the distinctness of the automobile insurance verification industry and the health care claims processing "as stated in paragraph 5 on page 10". Examiner is concerned that Applicant is arbitrarily ignoring case law that holds any art that is pertinent to the particular problem in which the application is concerned is analogous art. As such, and as described in this Office Action and the Final Office Action (paper number 8), the problem of inaccurate, incomplete and repetitive insurance databases is shared between the two. Further the Applicant argues that the "all insurance is not the same, but depends upon contract, industry specific probabilities and statutes and regulations" and that "Examiner has provided no support for her determination that these arts are analogous as therefore must accept the statements in the accompanying affidavit of Richard Kessler in this regard. [...] that the May health insurance claim procedure and the Garrett motor vehicle verification involve different industries with different databases, insurance codes, processing sequences, reviews and claims assessments" Examiner agrees all insurance depends on contract, probabilities, statutes, and



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regulations, and has databases, insurance codes, processing sequences and reviews. Even though the values of these items may be different for the May and Garrett references, since all insurance shares this common basic structure, and they further share the same problems of inaccurate, incomplete and repetitive data, they are analogous art. Therefore, the Examiner in no way ignored the nonanalogous issues but has addressed it, twice, and determined, twice, that the art is analagous.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not relied upon art teaches an on-line nationwide insurance verification database that each state is connected to that allows insurance to be verified at the time of fuel purchase by swiping an insurance card at the fuel station (6,233,563 B1), a system for viewing automobile insurance status remotely (6,526,386).

9. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**Or faxed to:**

(703) 305-7687 [Official communications]  
(703) 746-7238 [After Final communications, labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet D. Chance whose telephone number is (703) 305-5356.

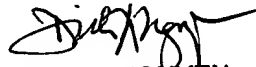
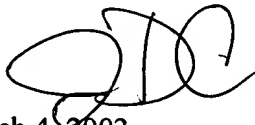
The examiner can normally be reached on M-F 7:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (703) 305-9588. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7687 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

jdc

March 4, 2003



DINH X. NGUYEN  
PRIMARY EXAMINER

## Recent Statutory Changes to 35 U.S.C. § 102(e)

On November 2, 2002, President Bush signed the 21st Century Department of Justice Appropriations Authorization Act (H.R. 2215) (Pub. L. 107-273, 116 Stat. 1758 (2002)), which further amended 35 U.S.C. § 102(e), as revised by the American Inventors Protection Act of 1999 (AIPA) (Pub. L. 106-113, 113 Stat. 1501 (1999)). The revised provisions in 35 U.S.C. § 102(e) are completely retroactive and effective immediately for all applications being examined or patents being reexamined. Until all of the Office's automated systems are updated to reflect the revised statute, citation to the revised statute in Office actions is provided by this attachment. This attachment also substitutes for any citation of the text of 35 U.S.C. § 102(e), if made, in the attached Office action.

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 in view of the AIPA and H.R. 2215 that forms the basis for the rejections under this section made in the attached Office action:

**A person shall be entitled to a patent unless –**

**(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.**

35 U.S.C. § 102(e), as revised by the AIPA and H.R. 2215, applies to all qualifying references, except when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. For such patents, the prior art date is determined under 35 U.S.C. § 102(e) as it existed prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. § 102(e)).

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 prior to the amendment by the AIPA that forms the basis for the rejections under this section made in the attached Office action:

**A person shall be entitled to a patent unless –**

**(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.**

For more information on revised 35 U.S.C. § 102(e) visit the USPTO website at [www.uspto.gov](http://www.uspto.gov) or call the Office of Patent Legal Administration at (703) 305-1622.